

### **REMARKS**

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the pending claims and the following remarks.

#### ***Amendments to the Claims***

Claims 1-9 are pending in the present application. Claims 1, 4 and 8-9 have been amended.

No new matter has been added by way of these amendments because each amendment is supported by the present specification or corrects improper “use” claims. For example, the amendments to claims 1 and 4 find support in the specification at, *inter alia*, page 17, line 22 to page 19, line 4 and page 22, lines 16-17.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

#### ***Issues under 35 U.S.C. § 101***

The Examiner has rejected claims 8 and 9 under 35 U.S.C. § 101 for being improper “use” claims. Per the Examiner’s suggestion, the claims have been amended into “method” claims. Thus, Applicants respectfully submit that the amendments overcome the outstanding rejection and that the rejection be removed.

#### ***Obviousness-type Double Patenting***

1) The Examiner has rejected claims 1, 6 and 8 under the doctrine of obviousness-type double patenting over claims 1-7 of U.S. Patent No. 6,802,993. Applicants respectfully traverse this rejection.

U.S. Patent No. 6,802,993 discloses a photochromic curable composition comprising a polyfunctional radically polymerizable monomer having at least three polymerizable groups in the molecule (see col. 2, lines 14-15).

Monomers represented by the formulas (2) and (2') and their examples are disclosed as the above polyfunctional radically polymerizable monomer in col. 3, line 25 to col. 4, line 3.

However, U.S. Patent No. 6,802,993 fails to disclose or suggest the component (B1) specified in claims 1 and 4 of the present application, the compounds represented by the formulas (7) and (10) and hydroxypivalic acid neopentylglycol diacrylate.

The composition of the present invention is a coating composition which is advantageously used as a coating composition to manufacture a photochromic plastic lens by a coating method. A photochromic layer obtained by using the coating composition has an excellent feature that it retains high adhesion even when it is kept under high humidity conditions for a long time.

U.S. Patent No. 6,802,993 also fails to disclose a coating composition that provides this advantage of the coating composition of the present invention.

Thus, Applicants respectfully submit that the above non-statutory obviousness-type double patenting rejection has been overcome and that the rejection be removed.

2) The Examiner has provisionally rejected claims 1 and 2 under the doctrine of obviousness-type double patenting over claim 11 of copending Application No. 10/484,896. As the rejection is a provisional rejection, no action is required by Applicants at this time. See MPEP 804, page 800-17.

***Issues under 35 U.S.C. § 112, second paragraph***

The Examiner has rejected claims 1, 2, 4-6 and 8 under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner states that the recited language for (B1) "other than the components (A1) which has at least one oxycarbonyl group in a molecule" in claims 1 and 4 is confusing since the recited monomer (A1) does not have any limitation with respect to said oxycarbonyl group.

Applicants have amended claims 1 and 4 to remove the confusing language. Thus, Applicants respectfully submit that the amendments overcome the outstanding rejection and that the rejection be removed.

***Issues over the Prior Art***

The Examiner has rejected claims 1, 6 and 8 under 35 U.S.C. § 102(a) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over WO 02/28930.

Applicants respectfully traverse, and reconsideration and withdrawal of this rejection is respectfully requested.

Applicants have noted page 4 of the outstanding Office Action. Applicants also note that WO 02/28930 corresponds to U.S. Patent No. 6,802,993.

As described above, WO 02/28930 fails to disclose a polymerization curable composition having photochromism containing a monomer compound represented by the formula (7) or (10) or hydroxypivalic acid neopentylglycol diacrylate. Therefore, WO 02/28930 does not teach each and every element of claim 1.

The composition of the present invention as recited in claim 1 is advantageously used as a coating composition to manufacture a photochromic plastic lens by a coating method. A photochromic layer obtained by using the coating composition has an excellent feature that it retains high adhesion even when it is kept under high humidity conditions for a long time.

The composition disclosed by WO 02/28930 is a polymerization curable composition which is used to manufacture a photochromic lens by a kneading method. WO 02/28930 fails to teach that when the composition is used as a coating composition and a monomer compound represented by the formula (7) or (10) or hydroxypivalic acid neopentylglycol diacrylate is used, the above excellent effect is obtained.

Applicants therefore respectfully submit that claims 1, 6 and 8 clearly distinguish over WO 02/28930. As such, the instant invention is not anticipated by nor rendered obvious over WO 02/28930, and withdrawal of the rejection is respectfully requested.

***Allowable Subject Matter***

Applicants acknowledge the indication of allowable subject matter of claims 3 and 7. However, for the reasons indicated above, all pending claims are believed to be directed to allowable subject matter.

### CONCLUSION

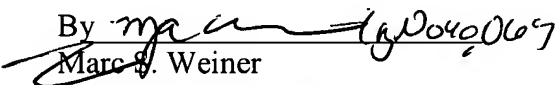
A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink, Reg. No. 58,258, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§ 1.16 or 1.147; particularly, extension of time fees.

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Respectfully submitted,

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